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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,516	07/16/2004	Sundar Raman	PL002-0022	4347
59769	7590	11/16/2007		
UTSTARCOM, INC. 3800 GOLF ROAD SUITE 220 ROLLING MEADOWS, IL 60008			EXAMINER DEAN, RAYMOND S	
			ART UNIT	PAPER NUMBER
			2618	
			MAIL DATE	DELIVERY MODE
			11/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/710,516

Applicant(s)

RAMAN, SUNDAR

Examiner

Raymond S. Dean.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see remarks filed September 11, 2007 with respect to the rejection(s) of claim(s) 1, 8, 22 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art Moores et al. (US 2004/0132432).

Moores teaches a cellular telephone device, comprising: a radio unit for transmitting over a cellular telephone network, the cellular telephone network capable of both in-band communication and out-of-band communication (Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer); a messaging unit operatively coupled to the radio unit to determine when a user of the cellular telephone device desires to record a cellular telephone conversation and, when the user of the cellular telephone device desires to record a cellular telephone conversation, to transmit a record enable signal via the radio unit using the out-of-band communication (Section 0062, when the user wants to transmit a start command there will be a determination or detection of such a transmission).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 – 3, 5 – 11, 14 – 16, 18 – 22, 24 – 25, 28 – 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Moores et al. (US 2004/0132432).

Regarding Claim 1, Moores teaches a cellular telephone device, comprising: a radio unit for transmitting over a cellular telephone network, the cellular telephone network capable of both in-band communication and out-of-band communication (Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer); a messaging unit operatively coupled to the radio unit to determine when a user of the cellular telephone device desires to record a cellular telephone conversation and, when the user of the cellular telephone device desires to record a cellular telephone conversation, to transmit a record enable signal via the radio unit using the out-of-band communication (Section 0062, when the user wants to transmit a start command there will be a determination or detection of such a transmission).

Regarding Claim 8, Moores teaches communications equipment capable of communicating with a remote cellular telephone device and of recording telephone conversations (Sections 0054, 0062) therewith, the communications equipment comprising: a cellular base station for receiving a cellular telephone conversation with a remote cellular telephone device on an in-band channel and for receiving a record enable signal from the remote cellular telephone device on an out-of-band channel (Figure 1, Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer, both forms of communication will initially be received by a base station); and a recorder operatively coupled to the cellular base station to receive the telephone conversation on the traffic channel and record the conversation upon the record enable signal (Section 0062).

Regarding Claim 22, Moores teaches a method of communicating over a cellular telephone to record voice conversations, the method comprising the steps of: transporting a cellular telephone conversation between a remote cellular telephone device and a base station on an in-band communication (Figure 1, Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer, both forms of communication will initially be received by a base station); transporting a record enable signal from the remote cellular telephone device to the base station on an out-of-band

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communication (Figure 1, Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer, both forms of communication will initially be received by a base station); and recording the telephone conversation upon an enable signal (Section 0062).

Regarding Claims 2, 25, Moores teaches all of the claimed limitations recited in Claims 1, 24. Moores further teaches wherein the in-band communication is a traffic channel; and wherein the out-of-band communication is a signaling channel (Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications, which occurs via a traffic channel and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer, which occurs via a signaling channel).

Regarding Claims 3, 11, Moores teaches all of the claimed limitations recited in Claims 2, 8. Moores further teaches wherein the in-band communication is a voice channel (Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications thus there will be a voice channel).

Regarding Claims 5, 14, 28, Moores teaches all of the claimed limitations recited in Claims 2, 10, 24. Moores further teaches wherein the out-of-band communication is sent using an Internet protocol (Section 0090).

Regarding Claims 6, 15, 29, Moores teaches all of the claimed limitations recited in Claims 2, 10, 24. Moores further teaches wherein the out-of-band communication is a cellular data channel (Figure 1, this is a cellular network thus there will be cellular data channels).

Regarding Claim 7, Moores teaches all of the claimed limitations recited in Claim 1. Moores further teaches wherein the record enable signal comprises a record start signal and a record stop signal (Section 0062); wherein the messaging unit is operatively coupled to the radio unit to transmit the record start signal via the radio unit using the out-of-band communication when the user of the cellular telephone device desires to start recording the cellular telephone conversation (Section 0062); and wherein the messaging unit is operatively coupled to the radio unit to transmit the record stop signal via the radio unit using the out-of-band communication when the user of the cellular telephone device desires to stop recording the cellular telephone conversation (Section 0062).

Regarding Claim 9, Moores teaches all of the claimed limitations recited in Claim 8. Moores further teaches a media gateway operatively coupling the cellular base station to the public switched telephone network to transport telephone communications between the remote cellular telephone device and a remote public switched telephone device (Figure 1, typical cellular systems comprises media gateways that couple the base stations to the PSTN).

Regarding Claim 10, Moores teaches all of the claimed limitations recited in Claim 8. Moores further teaches wherein the in-band communication is a voice

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channel (Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications, which occurs via a voice channel and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer, which occurs via a signaling channel); and wherein the out-of-band communication includes a signaling channel to carry the record enable signal (Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications, which occurs via a voice channel and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer, which occurs via a signaling channel).

Regarding Claim 16, Moores teaches all of the claimed limitations recited in Claim 8. Moores further teaches a mobile switching center operatively coupled to the cellular base station to fork off a communication signal to the recorder upon receipt of the enable signal (Figure 1, Section 0062, in order for the central computer to receive and record the communication said communication will need to be forwarded or forked off via the MSC).

Regarding Claims 18, 30, Moores teaches all of the claimed limitations recited in Claims 8, 22. Moores further teaches wherein the record enable signal comprises a record start signal and a record stop signal (Section 0062); wherein the cellular base station receives the record start signal from the remote cellular telephone device on an out-of-band channel; and wherein the cellular base station receives the record stop signal from the remote cellular telephone device on an out-of-band channel (Section



0062); and wherein the voice recorder receives the voice conversation on a voice channel and starts recording the voice conversation upon the record start signal and stops recording the voice conversation upon one of at least either the record stop signal and an end of the voice conversation (Section 0062).

Regarding Claim 19, 31, Moores teaches all of the claimed limitations recited in Claims 8, 22. Moores further teaches a media gateway operatively coupled to the cellular base station and the voice recorder to save and provide for future remote retrieval of the recorded conversation (Figure 1, Section 0073 lines 1 – 16, typical cellular systems comprises media gateways that couple the base stations to the PSTN).

Regarding Claim 20, Moores teaches all of the claimed limitations recited in Claim 19. Moores further teaches wherein the media gateway provides for future remote retrieval of the recorded conversation using an interactive menu of at least one of visual and audible menus (Section 0073 lines 1 – 16).

Regarding Claims 21, 32, Moores teaches all of the claimed limitations recited in Claims 19, 22. Moores further teaches wherein the media gateway forwards the recorded conversation to a distribution location using a standard digital encoded format (Section 0090, in order for the recorded conversations to be accessed via the web said conversations will need to be in a digital format), stores the conversation as a link on a website and provides the web address to each of the calling parties via at least one of voice message and text message (Sections 0090, 0093, e-mail messages comprise text).

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Regarding Claim 24, Moores teaches all of the claimed limitations recited in Claim 22. Moores further teaches wherein the in-band communication includes a voice channel; and wherein the out-of-band communication includes a non-voice channel (Sections 0050, 0062, the in-band communication is the communication between the mobile phones such as voice communications, which occurs via a voice channel and the out-of-band communication is the signaling used to transmit the recording instructions to the central computer, which occurs via a signaling channel, which is a non-voice channel).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 12, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moores et al. (US 2004/0132432) in view of Aschir (US 2003/0186682).

Regarding Claims 4, 12, 26, Moores teaches all of the claimed limitations recited in Claims 2, 10, 24. Moores does not teach wherein the out-of-band communication is a short message data channel.

Aschir teaches communication via a short message data channel (Section 0024 lines 1 – 6).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the SMS data communication of Aschir as an alternative means of communication for the mobile device.

6. Claims 17, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moores et al. (US 2004/0132432) in view of Osann (US 2004/0203608).

Regarding Claim 17, Moores teaches all of the claimed limitations recited in Claim 16. Moores does not teach wherein the mobile switching center forwards the voice signal to the voice recorder using a streaming protocol.

Osann teaches wherein the mobile switching center forwards the voice signal to the voice recorder using a streaming protocol (Section 0024 lines 8 – 11, voice, images, and video via the web is typically streamed).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moores with the streaming protocol of Osann as an alternative means of transmitting voice communication.

Regarding Claim 23, Moores teaches all of the claimed limitations recited in Claim 22. Moores does not teach the step of transporting telephone communications between the remote cellular telephone and another telephone on a network.

Osann further teaches the step of transporting telephone communications between the remote cellular telephone and another telephone on a network (Sections 0022, 0023).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moores with the transport method of Osann for purpose of communicating other types of devices thus enabling a more versatile system.

7. Claims 13, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moores et al. (US 2004/0132432) in view of Aschir (US 2003/0186682), as applied to Claims 12, 26 above, and further in view of Olsson et al. (5,915,222).

Regarding Claims 13, 27, Moores in view of Aschir teaches all of the claimed limitations recited in Claims 12, 26. Moores in view of Aschir does not teach wherein the short message data channel uses SS7 signaling.

Olsson teaches wherein the short message data channel uses SS7 signaling (Col. 3 lines 10 – 17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Moores in view of Aschir with the SS7 feature of Olsson as a means for transporting the SMS data as taught by Olsson.

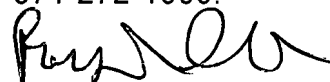
### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond S. Dean whose telephone number is 571-272-7877. The examiner can normally be reached on Monday-Friday 6:00-2:30.

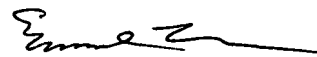
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban can be reached on 571-272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raymond S. Dean  
November 8, 2007



EDWARD F. URBAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600